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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/039,687	10/25/2001	Robert Muir	13625/003001/106697	9508

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FISH & RICHARDSON, PC
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SAN DIEGO, CA 92130-2081

EXAMINER

NGUYEN, KIM T

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,687

Applicant(s)

MUIR, ROBERT

Examiner

Kim Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 and 26-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 15, 17 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Applicant's election in response to the restriction requirement on September 17, 2003 (paper No. 9) is acknowledged. Currently, applicant elects species 1, claims 5-8 and 22-25, with generic claims 1-4, 17-21, and 31, without traverse. Claims 1-31 are pending in the application.

Claim Objections

1. Claims 1, 3, 7-8, 17-21, 25, and 31 are objected to because of the following informalities:
 - a) In claim 1, line 4, the claimed limitation “the gaming machine” should be corrected to “a gaming machine”.
 - b) In claim 1, line 9, the claimed limitation “the player” should be corrected to “a player”.
 - c) In claim 3, lines 1-2; claim 4, line 2; and claim 21, line 2; the claimed limitation “simulated three-dimensional images” should be corrected to “simulated three-dimensional additional parts” to be consistent with the “simulated three-dimensional additional parts” in claim 1, lines 5-6.
 - d) In claim 4, line 4; and claim 21, line 4; the claimed limitation “a composite image” should be corrected to “the composite image”.
 - e) In claim 7, lines 2-3, the claimed limitation “the additional 3D objects” should be corrected to “the simulated three-dimensional additional parts” to be consistent with the “simulated three-dimensional additional parts” in claim 1, lines 5-6.

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f) In claim 8, line 1, the claimed limitation “3D objects” should be corrected to “simulated three-dimensional additional parts” to be consistent with the “simulated three-dimensional additional parts” in claim 1, lines 5-6.

g) In claim 17, lines 1-2, the claimed limitation “the real-time 3D objects” should be corrected to “the real-time non-varying parts”.

h) In claim 18, line 5, the claimed limitation “a game” should be corrected to “the game”.

I) In claim 19, lines 1-2, the claimed limitation “simulated 3D images” should be corrected to “simulated three-dimensional additional parts” to be consistent with the “simulated three-dimensional additional parts” in claim 18, line 6.

j) In claim 19, line 2, the claimed limitation “non-varying images” should be corrected to “non-varying parts”.

k) In claim 25, lines 1-2, the claimed limitation “additional 3D objects” should be corrected to “simulated three-dimensional additional parts”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 17 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) In claim 17, lines 1-2, the claimed limitation “the real-time 3D objects ... the 3D object” is ambiguous. It is not clear if the “real-time 3D objects” is the “real-time non-varying parts”, or the “simulated three-dimensional additional parts”; and it is not clear if the “3D object” is the “real-time non-varying parts”, or the “simulated three-dimensional additional parts”.

b) Claim 31 is similarly rejected as explained in claim 17 above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8, 17-25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waters et al (US. patent No. 6,359,619).

a. As per claim 1-2, Waters discloses a graphic package for use in a system. The package includes a storage device for storing data of non-varying parts (col. 6, lines 22-24; and col. 3, lines 52-57), an image operating means for generating the 3D additional parts of the image (col. 5,

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lines 41-43; col. 7, lines 21-23; and col. 11, lines 28-34). Waters does not disclose that the additional parts are dependent on the game outcome. However, Waters discloses that the graphic package of Waters can be implemented in game machines that show or hide details (col. 5, lines 53-62). An ordinary skill in the art at the time the invention was made would be able to use the additional parts as the output of the game outcome in order to facilitate showing or hiding the outcome of the game.

- b. As per claim 3-8 and 17, rendering 3D images using 3D computer rendering software, compositing images to be displayed, using Z buffer compositor, Z buffer depth value, etc. would have been well known to a person of ordinary skill in the art at the time the invention was made.
- c. As per claim 18-19, refer to discussion in claim 1 above.
- d. As per claim 20, determining the game outcome would have been well known.
- e. As per claim 21-25 and 31, refer to discussion in claims 4-7 and 17 above.

Cited Reference

- 5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Winner et al (US. 5,920,687) discloses using Z buffer in a graphics system (abstract).

- 6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can

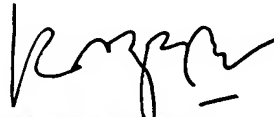
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normally be reached on Monday-Thursday from 8:00AM to 5:00PM ET. The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

kn

Date: October 18, 2003


KIM NGUYEN
PRIMARY EXAMINER